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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,727	12/05/2003	Mark E. Herrmann	R0586-701110	1722

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
3714	

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08/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/728,727	HERRMANN ET AL.	
	Examiner	Art Unit	
	Benjamin W. Lee	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02/26/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed on 05/02/2007 has been entered. Claims 1-35 are pending in this application. Claims 1, 9, 12, 18, 19, 25, and 29 have been amended.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

> The oath or declaration is defective because:
> It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to **patentability** as defined in 37 CFR 1.56.

The declaration filed on 04/16/2004 states that, "I acknowledge the duty to disclose information which is material to the **examination** of this application in accordance with Title 37, Code of Federal Regulations, §1.56." A new declaration should be submitted with "material to the examination" changed to --material to the patentability--.

Specification

3. The disclosure is objected to because of the following informalities: On page 5 of applicant's amendments to the specification filed on 05/02/2007, "winner (200)" at the end of the middle paragraph should be --winner (220)--.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re claim 12: The claim is directed toward a wagering game. It appears the claim is directed towards a manufacture since there are no method steps recited. However, the body of the claim only consists of abstract ideas (having a primary method of entry and an alternative method of entry). There is no physical transformation present to establish a practical application of the abstract ideas. Furthermore, there is no useful, concrete, and tangible result. Therefore, the claim is directed toward nonstatutory subject matter since the claimed invention consists solely of abstract features and does not recite any physical structure.

Re claims 13-24: The claims are dependent on claim 12 and do not resolve the deficiency of claim 12.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 5-8, 11, 25-28, 34, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Metke (US 6,565,435 B2).

Re claim 1: Metke discloses a method for conducting a game, the method comprising acts of providing a primary method of entry of at least one player in the game (non-free play, inherent for video arcades, see col. 1, lines 13-24); providing, to the at least one player, an alternative method of entry (AMOE) to the game (free play or free entry, see col. 1, lines 51-67); and executing the game for the at least one player (see step 110 in Fig. 2).

Re claim 25: The teachings of Metke as applied to claim 1 above have been discussed. Metke further discloses a computer-readable medium storing instructions to perform the method of claim 1. The game machine and free-play system are computerized and thus inherently includes a computer-readable medium storing instructions (see Fig. 2; col. 2, lines 10-52).

Re claims 5 and 34: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses the free play system is directed towards tournaments (see col. 1, lines 25-38) which implies the games are games of skill and thus have non-fixed odds of winning the game.

Re claims 6 and 26: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses an act of conducting the game over a communication network (see col. 2, lines 20-29).

Re claims 7 and 27: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses the act of providing entry of the at least one player in the game includes an act of entering the at least one player in a game session following a processing of an entry request of the at least one player by the alternative method of entry (AMOE). The player is entered by free-play after the authorization is transmitted (see col. 2, lines 53-65).

Re claims 8 and 28: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses an act of providing to the at least one player an indication of a game session to be entered by the alternative method of entry (AMOE). The player is disclosed to be physically located at the game unit and thus will know which game session will be entered (see col. 2, lines 53-65).

Re claims 11 and 35: The teachings of Metke as applied to claims 1 and 25 above have been discussed. Metke further discloses the act of providing for the alternative method of entry (AMOE) includes providing for an entry of the at least one player in at least two game sessions (see col. 1, lines 31-34: "Generally speaking, in order to play in a tournament, the player may play one or more rounds...").

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 2, 4, 9, 10, 12-20, 22-24, 29-31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metke in view of Itkis et al. (US 2003/0171986 A1, hereinafter Itkis).

Re claims 2, 4, 31, and 33: The teachings of Metke as applied to claims 1 and 25 above have been discussed.

However, Metke fails to explicitly disclose that the game is a wagering game of chance and the game has fixed odds of winning.

Itkis discloses a bingo game with a free method of entry. The game is a wagering game of chance (the winner is randomly selected, see ¶ [0013]) and the game has fixed odds (see ¶ [0032], lines 27-33).

Therefore, in view of Itkis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement video games of Metke with a bingo wagering game of chance with fixed odds of winning in order to create a promotional event directed towards fans of bingo and gain a wider audience.

Re claims 9, 10, 29 and 30: The teachings of Metke as applied to claims 7 and 27 above have been discussed.

However, Metke fails to disclose executing the game for the at least one player further includes the acts of determining at least one game card for the at least one player, determining a winning pattern prior to a game session, drawing winning cell content from a predetermined set of cell content, determining whether the pattern of cell content on the game card matching the drawn winning cell content makes a pattern matching the winning patter, and if so, determining a payout based upon a fixed odds of winning.

Itkis discloses an act of conducting the wagering game of chance, the act of conducting further comprising acts of determining, for the at least one player, at least one game card having a pattern (10), determining, prior to a game session, a winning pattern (13), drawing winning cell content from a predetermined set of cell content (39 and 40), determining if, for the at least one player, whether the pattern of cell content on the game card matching the drawn winning cell content makes a pattern matching the winning pattern (39), and if so, determining payout (43) (see Figs. 1 and 2; paragraph [0020]; paragraph [0024]-[0026]). Itkis further discloses the act of determining the payout includes an act of determining the payout based upon a fixed odds of winning (see paragraph [0032], lines 27-33).

Therefore, in view of Itkis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement video games of Metke with a bingo game in order to appeal to fans of bingo and gain a wider audience.

Re claim 12: Metke discloses a game having a primary method of entry (non-free play, inherent for video arcades, see col. 1, lines 13-24) and an alternative method of entry (AMOE) (free play or free entry, see col. 1, lines 51-67), wherein the game player plays the wagering game through the use of the alternative method of entry (in tournament play, see col. 1, lines 51-67).

Re claims 13 and 14: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses the wagering game is available to be played on a communication network/Internet (see col. 2, lines 20-29).

Re claims 15 and 16: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses the AMOE is performed by an act of submitting an entry to the wagering game by mail and Internet/e-mail (see col. 2, lines 37-40).

Re claim 17: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses a game session associated with the wagering game is provided with an entry by AMOE (authorizing information provided by AMOE must be sent to the game unit, see col. 2, lines 53-65).

Re claim 18: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses a game session entered is the next starting game session after the AMOE is received and logged by the game operator. The authorization information may be instantly transmitted directly to the game unit, and thus the player will play in the next starting game session (see col. 2, lines 37-52).

Re claim 19: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses a game session entered is the next starting game session designated for AMOE game players after the AMOE is received and logged by the game operator. The request for free play/AMOE inherently designates the games the player requests as games for AMOE players.

Re claims 20 and 22: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Itkis further discloses a bingo game with a free method of entry. The game is a wagering game of chance (the winner is randomly selected, see ¶ [0013]) and the game has fixed odds (see ¶ [0032], lines 27-33).

Re claims 23: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses the wagering game has non-fixed odds of winning the game. Metke further discloses the free play system is directed towards tournaments (see col.

1, lines 25-38) which implies the games are games of skill and thus have non-fixed odds of winning the game.

Re claim 24: The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed. Metke further discloses entry of the at least one player in at least two game sessions (see col. 1, lines 31-34: "Generally speaking, in order to play in a tournament, the player may play one or more rounds...").

11. Claims 3 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itkis in view of Langan (US 5,782,470).

The teachings of Metke as applied to claims 1 and 25 above have been discussed.

However, Metke fails to explicitly disclose the game is a wagering game of skill.

Langan teaches a wagering game of skill in which the outcome of the game is dependent upon the ability of the player in predicting the real-life performance of selected professional sports players (see col. 4, lines 5-14).

Therefore, in view of Langan, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement video games of Metke with the wagering game of skill of Langan in order to attract players that are interested in sports-themed games and gain a wider audience.

12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Metke as modified by Itkis as applied to claim 12 above, and further in view of Langan.

The teachings of Metke as modified by Itkis as applied to claim 12 above have been discussed.

However, Metke and Itkis fail to explicitly disclose the game is a wagering game of skill.

Langan teaches a wagering game of skill in which the outcome of the game is dependent upon the ability of the player in predicting the real-life performance of selected professional sports players (see col. 4, lines 5-14).

Therefore, in view of Langan, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the amusement video games of Metke as modified by Itkis with the wagering game of skill of Langan in order to attract players that are interested in sports-themed games and gain a wider audience.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1, 3, 4, 5, 6, 7, 8, 11, 12, 13, 14, 15, 16, 17, 18, 19, 24, 25, 26, 27, 28, and 31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 6, 7, 8, 9, 15, 16, 17, 18, 19, 20, 21, 22, 25, 26, 27, 28, 29, and 32, respectively, of copending Application No. 11/049,399.

Re claims 1, 3-8, and 11: Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention obviously encompasses the claimed invention of the '399 Patent Application and differ only in the terminology.

For instance, in claim 1 of the present claimed invention, the Applicants recite: "A method for conducting a game, the method comprising acts of: providing for an entry of at least one player in the game; and providing, to the at least one player, an alternative method of entry (AMOE) to the game."

Whereas, in claim 1 of the '399 Patent Application, the Applicants claim: "A method for conducting a tournament-style game, the method comprising acts of: providing for an entry of at least one player into the tournament-style game; and providing, to the at least one player, an alternative method of entry (AMOE) into the tournament-style game."

Accordingly, in respect to the above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claim 1 of the '399 Patent Application as general teachings for a method for conducting a game. The instant claims obviously encompass the claimed invention of the '399 Patent Application.

Re claims 12-19, 24-28, and 31: Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention obviously encompasses the claimed invention of the '399 Patent Application and differ only in the terminology.

For instance, in claim 12 of the present claimed invention, the Applicants recite: "A wagering game wherein a game player plays the wagering game through the use of an alternative method of entry."

Whereas, in claim 15 of the '399 Patent Application, the Applicants claim: "A wagering game of skill wherein a game player is eligible to play the wagering game of skill through the use of an alternative method of entry (AMOE)."

Accordingly, in respect to the above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claim 15 of the '399 Patent Application as a general teachings for a wagering game of skill. The instant claims obviously encompass the claimed invention of the '399 Patent Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

15. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin W. Lee whose telephone number is 571-270-1346. The examiner can normally be reached on Mon - Fri (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronald Laneau
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PRIMARY EXAMINER
7/29/07

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July 25, 2007